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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/706,638

11/12/2003

Amit V. Patel

911

7888

7590

10/31/2006

Amit V. Patel  
2289 Willoway Street  
Yorktown Heights, NY 10598

EXAMINER

JACKSON, BRANDON LEE

ART UNIT

PAPER NUMBER

3772

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/706,638 | <b>Applicant(s)</b><br>PATEL, AMIT V. |  |
|                              | <b>Examiner</b><br>Brandon Jackson   | <b>Art Unit</b><br>3772               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 13-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/12/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/12/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims directed to the following patentably distinct species:

- I. Figures 1-3, 5-6 directed to claims 1-12
- II. Figure 4 directed at claims 13-23

The species are independent or distinct because Species I fails to show the support mechanism, which is depicted in Species II figure 4.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

During a telephone conversation with Amit Patel on 10/25/2006 a provisional election was made without traverse to prosecute the invention of Species I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "compressible padding" and "hook and loop fastener" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show "joint (130)" as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., "The

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compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet.

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

The disclosure is objected to because of the following informalities: the meaning of "et seq." on page 6, lines 29-30 is unclear.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Maddox (U.S. Patent 1,340,630). Maddox discloses an apparatus (fig. 1) for immobilizing an injured joint of the body comprising a first plate (35) adapted for engaging limb of the body and having an end portion. A second plate (12) adapted for engaging a body part to which the limb is connected via a joint, the second plate having an end portion. The first and second plates (35, 12) are contoured to receive a body part. A lockable joint (24, 26) connecting the first and second plates, which is a pivotable hinge having a locking mechanism (27, 28) for locking the hinge at desired orientations. The apparatus

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discloses at least one securing mechanism (47) attached to the first plate (35) and comprising a strap (47); and a second securing mechanism (16) attached to the second plate (12) and comprising a strap (16). The apparatus comprises compressible padding (36) attached to a concave surface of the first plate (35); and compressible padding (14) attached to a concave surface of the second plate (12). The apparatus has at least one securing mechanism comprising a strap (47) and fastener (18), of which the fastener comprises a hook and loop fastener. In view of the applicant's specifications, page 8, lines 19-21, the buckle (18) is seen to be equivalent to the hook and loop fastener. The first and second plates (35, 12) are capable of flexing into a concave orientation (fig. 2). Therefore, the term "capable" has been given its broadest, most reasonable interpretation and the device is capable of being concave. Further, being "capable" is a recitation of a function and is not a positive limitation but only requires the ability to perform. It does not constitute a limitation in any patentable sense. The first plate (35) apparatus is capable of being disassembled from the second plate (12). The wing nut (28) is capable of being removed, which will allow the screw (27) to be removed and the first plate (35) to be removed from the second plate (12). Therefore, the term "capable" has been given its broadest, most reasonable interpretation and the device is capable of being disassembled. Further, being "capable" is a recitation of a function and is not a positive limitation but only requires the ability to perform. It does not constitute a limitation in any patentable sense.

Claims 1-3 and 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (U.S. Patent 1,643,850). Jones discloses an apparatus (figs. 1, 2) for

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immobilizing an injured joint of a body comprising a concave first plate (1) for engaging a limb of the body, the first plate (1) having an end portion. A concave second plate (2) for engaging a limb of the body, the second plate (2) having an end portion. The apparatus has a lockable joint (8, 12) connecting the first and second plates (1, 2) that is a pivotable hinge having a locking mechanism (10, 11) for locking the hinge at desired orientations. The apparatus has at least one securing mechanism for the first plate (1), which is a strap (13); the second plate (2) also has a strap (14) as its securing mechanism. Each of the plates (1, 2) utilize buckles (15) as a fastener to the plates (1, 2). With respect to claim 9, and in view of the applicant's specification, page 8, lines 19-21, the buckle (15) is seen to be equivalent to the hook and loop fastener. The concave plates (1, 2) are contoured to receive a body part. The plates (1, 2) are capable of flexing into concave orientation. Therefore, the term "capable" has been given its broadest, most reasonable interpretation and the device is capable of being concave. Further, being "capable" is a recitation of a function and is not a positive limitation but only requires the ability to perform. It does not constitute a limitation in any patentable sense. The first plate (1) is capable of being disassembled from the second plate (2). Therefore, the term "capable" has been given its broadest, most reasonable interpretation and the device is capable of being disassembled. Further, being "capable" is a recitation of a function and is not a positive limitation but only requires the ability to perform. It does not constitute a limitation in any patentable sense.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148.

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (U.S. Patent 1,643,850) in view of Maddox (U.S. Patent 1,340,630). Jones discloses the invention substantially as claimed, see rejection to claim 1 above; however, fails to disclose specifically including compressible padding on the first and second plates. Maddox teaches the use of compressible padding (36) on the first plate (35) and compressible padding (14) on the second plate (12). It would have been an obvious matter of design choice to modify the first and second plates of Jones with the compressible padding of Maddox, since the applicant has not disclosed that foam solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the compressible padding taught by Maddox.

### **Conclusion**

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Van Dalsem (U.S. Patent 2,012,488), Lee (U.S. Patent 392,157), Lee (U.S. Patent 364,942), Hoppe (U.S. Patent 532,461), Hoppe (U.S. 504,218), Adams (U.S. Patent 186,700), Messersmith (U.S. Patent 859,962).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Jackson whose telephone number is (571)272-3414. The examiner can normally be reached on Monday - Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brandon Jackson  
Examiner  
Art Unit 3772

BJ

  
10/30/06